

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-16 are in the application. Claims 1, 13 and 14 have been amended.

In the Official Action, the Examiner objected to claims 13 and 14 for including informalities. Specifically, the Examiner noted typographical errors in both claims. In response, claims 13 and 14 have been amended to correct the typographical errors. It is respectfully submitted that the raised objections have been overcome.

The Examiner rejected claims 1-16 under 35 U.S.C. §101 as being allegedly directed to non-statutory subject matter. In particular, the Examiner noted that claim 1 "fails to recite a tangible result". In response, claim 1 has been amended to include the additional step of: "transmitting information related to said identified pieces of second intellectual property to the user". As amended, it is respectfully submitted that claim 1 includes a tangible result. Accordingly, it is respectfully submitted that claims 1-16 are in accord with 35 U.S.C. §101.

The Examiner rejected claims 1-16 as being allegedly anticipated by Lee (U.S. Patent No. 6,694,331).

Lee is directed to an apparatus and method of searching and organizing intellectual property information. With reference to Figure 1, the Lee system includes a server 30 and a user interface 35. The user interface 35 may include one or more display devices and one or more input devices. Col. 3, ll. 12-17. Individual control modules may be provided within the server 30, including: class search module 310; IP thesaurus module 312; and, field-of-search module 314. See, e.g., col. 3, ll. 1-5. Figure 3 sets forth the operation of the class search module 310. As set forth at column 6, lines 59-65,

A user performing a desired search is given access to and able to review the different subject headings, titles, and definitions in the classification system to locate and select the most pertinent classifications (step 502). Class search module 310 receives input data from user interface 35 regarding one or more classifications selected by the user.

The selected classifications “are used to define search criteria to be used in searching database 32 for desired intellectual property information (step 504).” Col. 7, ll. 11-13. The user may also apply other search criteria to the class search module 310, such as keywords, date restrictions, and Boolean logic operators. Col. 7, l. 63 - col. 8, l. 1.

With respect to the IP thesaurus module 312, this module is “programmed to receive input data or signals from a user (e.g., via user interface 35) identifying select intellectual property information to form or otherwise be designated as a source collection or grouping”. Col. 8, ll. 17-21. The user provides the necessary intellectual property information or provides access to such information to form the source grouping. Col. 8, ll. 30-44. Once the source grouping is retrieved, the information is reviewed and possibly modified. Col. 8, ll. 56-63.

Thus, with reference to Figure 4, and column 8, line 39 - column 9, line 9, the user iteratively reviews the retrieved data and enters keywords for additional searching.

The field-of-search module 314 is programmed like the IP thesaurus module to receive input data. Col. 10, ll. 41-45. With reference to Figure 5 and column 11, line 63 - column 12, line 29, the field-of-search module 314 requires user input.

Amended claim 1 is directed to a method for investigating intellectual property related to a reference piece of intellectual property including the steps of: searching a first database to identify pieces of a first intellectual property having predetermined characteristics in common with the reference piece of intellectual property; “developing without user involvement at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property”; and, searching a second database of a second, and different type of intellectual property, to identify pieces of the second intellectual property satisfying the at least one query.

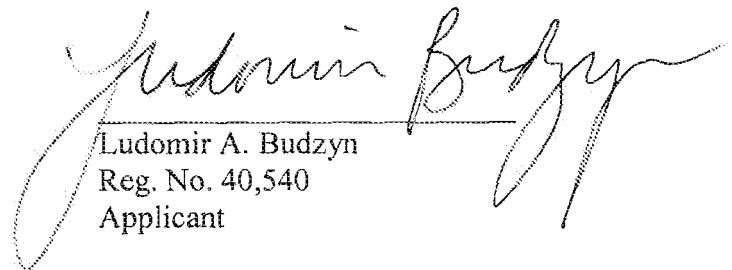
In contrast to the method of claim 1, Lee does not disclose or suggest a method which conducts a first search of one type of intellectual property and then develops at least one query for a second search of a different type of intellectual property without user involvement. Lee is concerned with conducting searches to identify potentially relevant intellectual property. See, e.g., col. 1, ll. 50-55. Lee relies on user involvement (i.e., by way of the user interface 35) to determine the search criteria in establishing relevancy. See, e.g., col. 6, ll. 59-65; col. 7, ll. 53-

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55; col. 7, ll. 59-63; col. 8, ll. 17-23; and, col. 10, ll. 40-45. With the subject invention, a search is conducted to identify possibly relevant prior art by inputting only once characteristics of a reference piece of intellectual property. It is respectfully submitted that claims 1-16 are patentable over Lee.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant at the number listed below.

Respectfully submitted,



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